

REMARKS

Claims 1-13, 15-17, and 25-36 are pending in this application, all of which have been rejected under 35 U.S.C. § 103(a). In particular, claims 1-3, 7-13, 15-17, 25-33, 35, and 36 have been rejected as being unpatentable over U.S. Patent No. 6,331,865 (Sachs) in view of U.S. Patent No. 6,415,270 (Rackson). Claims 4-6 have been rejected as being unpatentable over Sachs in view of Rackson and U.S. Patent No. 6,324,288 (Hoffman). Claim 34 has been rejected as being unpatentable over Sachs in view of Rackson and of a purported fact of which the Examiner has taken Official Notice. Applicants respectfully disagree with the stated grounds of rejection and traverse.

First, as to independent claim 1, applicants note that there is a feature of this claim that the Examiner has not found to be taught in any of the applied prior art, and has not addressed at all. In particular, claim 1 recites “providing a set of computer-executable instructions to a plurality of second computing devices.” Subsequently, with reference to a “list” of web sites that distribute digital content items, claim 1 recites “limiting the set of web sites on said list to web sites that vend or distribute content that is renderable by said set of computer-executable instructions.” The Examiner has not addressed this feature anywhere in the Office Action. Applicants note that, in the amendment filed on April 15, 2005, applicants have explained why this feature is not present in Sachs. Moreover, this feature is not present in the newly-cited Rackson and Hoffman references. If the Examiner believes that this feature is present in Sachs, Rackson, or Hoffman – or in some reference that has not yet been cited – applicants request that the Examiner set forth an explanation of where this feature is taught in a non-final office action, so that applicants can have a meaningful opportunity to respond.

With respect to all of the independent claims – 1, 13, 17, 25, and 30 – each of these claims was amended in the April 15, 2005 paper to recite certain features. Applicants note that claims 1, 13, 17, 25 and 30 are not identical, and should not be construed as having identical scope. However, these claims have certain commonalities, and thus applicants will treat them together for the sake of argument. In particular, each of the presently-pending independent claims recites that a web site, commerce site, or address of a computing device is included on a list by virtue of the fact that some party has met the terms of an offer. With

regard to all of the presently-pending independent claims, the Examiner has addressed these features as follows:

Regarding limitations added in the most recent amendment, Sachs fails to explicitly disclose limiting the set of web sites that vend or distribute content based on meeting the terms of an offer of [sic] to sell space on the list.

Rackson teaches the use of registering sellers and charging them a fee for listing items for sell [sic]. It is inherent that the seller agrees to the fees required by the listing agent.

Applicants note that the Examiner has not provided column or line cites to portions of Rackson, but rather has merely asserted that Rackson teaches what is described in the above block quote. While it is difficult for applicants to respond to the Examiner's unsupported assertion about what Rackson teaches, applicants will attempt to address the Examiner's point.

Rackson is entitled "Multiple Auction Coordination Method and System," and appears to be directed to a system for auctioning items. Rackson does mention that an auction service can charge a fee for running an auction, which includes a "listing fee." Rackson appears to describe this charge as the cost of running the auction, rather than a charge for inclusion on a list. (See col. 8, ll. 42-48.) Thus, it does not appear that the "listing fee" constitutes the offer referred to in the independent claims. (We note that claim 1 refers to an "offer to be included in said list"; claim 25 refers to an "offer ... to be included among said commerce sites"; and claim 30 refers to an "offer for said inclusion".) Thus, Rackson does not teach the features for which it is apparently relied upon.

However, even if Rackson's listing fee could be considered an offer to list an item for sale, applicants note that Rackson's listing of an item for sale in an auction is not the type of listing that occurs in the claims. The independent claims refer to lists of web sites, commerce sites, or addresses of computing devices that vend and/or distribute content. By contrast, the "listings" in Rackson are of items for sale. A list of web sites, commerce sites, or addresses of computing devices that vend and/or distribute content is not the same thing as a list of items that are being auctioned off for sale. The web sites, commerce sites, and addresses on the list are not being offered for sale. An offer to include such sites or addresses on a list is an entirely different type of commercial transaction than is the listing of an item for sale in an

auction. The lists in the independent claims are of places where things are sold; they are not lists of things that are for sale. Even if Rackson can properly be understood as charging a fee to list an item for sale, this fact does not teach or suggest the claim feature of meeting an offer as a condition for including ones web site, commerce site, or address in a list. Thus, applicants respectfully submit that all of the independent claims – 1, 13, 17, 25, and 30 – recite features that are not taught or suggested in the applied prior art. Applicants thus request that the rejection of these claims be reconsidered and withdrawn.

Information Disclosure Statement

A supplemental Information Disclosure Statement was filed on August 1, 2005. Applicants request that the Examiner initial and return this IDS in a subsequent Office Action.

Official Notice

Applicants note that the Examiner has taken Official Notice of a purported fact. Applicants explicitly do not acquiesce in this taking Official Notice. In particular, applicants traverse the Official Notice on the ground that the Examiner has not pointed to any evidence that it “was old and well known … to attach logo [sic] to web site links.” While one might assert that logos are old and that web sites links existed as of the present invention’s filing date, it is unclear on what basis – e.g., documentary evidence, or personal knowledge – the Examiner is relying upon to assert that the logos and links are “attached” (or what the Examiner means by “attached” in this context).

However, applicants note that the purported fact as to which Official Notice has been taken does not relate to the features that have been the subject of the foregoing argument. Applicants submit that the appropriateness of the Official Notice should be addressed – if at all – at a later date if the applicants should decide to rely for patentability on the feature as to which Official Notice has been taken. To the extent that the Examiner has asserted that MPEP 2144.03 would foreclose such later discussion, applicants respectfully submit that the Examiner has overstated the import of MPEP 2144.03, and that it is possible at a later date to discuss factual conclusions if and when those facts become germane.

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PATENT

Conclusion

For the reasons set forth above, applicants have demonstrated that independent claims 1, 13, 17, 25, and 30 are patentable over the applied prior art. Moreover, applicants have demonstrated a separate and additional reason why claim 1 is patentable over the applied prior art. Finally, the remaining claims are patentable at least by reason of their dependency. All claims have thus shown to be patentable, and applicants request that the Examiner reconsider the rejection and allow the case.

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